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EXAMINER

OCAMPO, MARIANNE S

ART UNIT PAPER NUMBER

1723

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,333

Applicant(s)

WINTER ET AL.

Examiner

Marianne S. Ocampo

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-11 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-11 and 26-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicants' amendments (Paper no. 9) filed on 6-2-03, have amended claims 4 – 11, which were originally referring to a subcombination in the form of the rigid injection moulded cylindrical canister (during prosecution, the examiner has considered this subcombination to be capable of being used with a paper roll as filter media and has considered that the paper roll as filter media is not positively included as part of the claimed invention) in such a manner that a shift from the subcombination has been made, since these claims are now referring to a combination in the form of a filter element comprising the rigid injection moulded cylindrical canister and the paper roll (filter media). Applicants have been given this consideration and the examiner has permitted the shift from the previously elected subcombination/invention to the non-elected combination/invention and acknowledging that the invention (i.e. combination) now claimed in amended claim 4, in essence is the previously non-elected invention presented as original claim 12 (which has been canceled by amendments on 10-18-02). Newly added claims 26 – 34 are also referring to the combination which is a filter element comprising the canister and the paper roll filter media.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the following features (in *italic*) as claimed in claims 26 – 28 and 34 lack proper antecedent basis in the specification.

- The grooves being spaced *so that as the canister is progressively slid off the male mould member the ribs do not all encounter grooves at the same time* (new claim 26), in this instance, the examiner is unclear as to how this is possible and cannot find enough evidence in the original specification for this feature;
- The (plural) *ribs are unevenly spaced* (new claims 27 and 31), although support for this is found in the figure 9.
- *Adjacent ribs are spaced by rib spacing, the rib spacing varying along the inner surface*), although support for this is found in the figure 9 (new claim 28), and
- *Said outer surface has an outward facing annular rib at said open end* (new claim 34), although support for this is found in the figure 9 (The examiner has considered the outward facing annular rib to be the flared portion/member 36).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains (new) subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. What is considered as new subject matter in claim 26 is “the grooves are spaced *so that as the canister is progressively slid off the male mould member the ribs do not all encounter grooves at the same time*”. **Any new matter must be canceled.**

Claim Objections

5. Claims 5 – 11 are objected to because of the following informalities: the preamble “The canister according to claim 4” should be changed to “The filter element according to claim 4”, in order to prevent confusion that the now amended claim 4 is actually claiming a filter element and not a canister, and since all dependent claims actually include claimed features (i.e. of the filter element) of the independent claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 4, 7 – 11, 27 – 29 and 33 - 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindberg et al. (WO 97/19737).

8. With respect to claim 4, Lindberg et al. disclose a filter element comprising:

- a rigid generally cylindrical canister (10) having an internal diameter, an open (top) end (in the vicinity of member 14) and a thin side wall having an outer surface and an inner surface and,
- a paper roll (12) as filter media and the paper roll (12) having a marginally greater diameter than the internal diameter of the canister prior to insertion into the canister (10) and
- spaced anti-tracking ribs (spaced annular ridges) projecting from the inner surface of the side wall (10) at a distance from the inner surface, and

- the canister being *sufficiently rigid* (has been considered by the examiner to include those which are reusable/recyclable materials which inherently possess a stiffness or physical stability upon use/exposure to fluids during filtration) and the paper roll being sufficiently tightly wound that the paper roll (12) when inserted into the canister (10) using a press, is substantially compressed to the internal diameter of the canister (10) without distortion of the canister (10). See fig. 1 and pages 7 - 10.

Although Lindberg et al. do not disclose explicitly the rigid (polymeric/plastic) canister (10) being injection moulded or that it (rigid canister) was formed by injection molding, it is considered an obvious variant of the claimed invention, and it is possible the polymeric rigid canister of Lindberg may be formed in the same manner/by injection molding by choice of the manufacturer, and even though, there is a difference in the method of making the prior art rigid canister (which could have been made by blow molding or casting or other methods), it is considered that the claimed invention (i.e. filter element having an injection moulded canister) and the prior art (filter element of Lindberg et al. having a rigid polymeric canister) would not perform differently from that of the claimed invention. Claim 4 is a product by process claim. The patentability of a product by process claim is based upon the product itself, even though the claim is limited and defined by process (i.e. the canister of the filter element being formed by injection molding), and therefore, the product in such a claim is unpatentable if it is the same as, or obvious from the product of the prior art, even if the product of the prior art had been made by a different process. See *In re Thorpe, et al.*, No. 85-1913 (11-21-85) 227 USPQ pages 964 – 966.

9. Concerning claim 7, Lindberg et al. further disclose:

- (at least a pair of) the ribs/ridges being evenly (uniformly) spaced from (each pair of) other ribs/ridges on the inner surface of the side wall, as in fig. 1, and
- the side wall (forming the canister 10 of Lindberg et al.) having a slight taper on the inner surface thereof, as in fig. 1.

10. With regards to claim 8, Lindberg et al. also disclose:

- the canister including a marginal taper (flare 14) on the inner surface at the open end to act as lead-in for the paper roll (12), as in fig. 1 and page 10, lines 3 – 5.

11. Regarding claims 9 - 11, Lindberg et al. disclose the filter element including:

- a base (15) and the base being inwardly dished (claim 9), in order to provide a bias against loading as the paper roll (12) filter media is pressed into the canister (10), as in fig. 1 and page 10, and
- the base (end wall 15) having an inner surface with radially extending flow passages (formed between projections to allow filtrate to track/flow across the end wall into the center core 13) separated by lands (projections on end wall 15) which define a supporting surface to evenly distribute and support the paper roll filter media (12) across the base (15) of the canister (10) to provide secondary flow passages (i.e. radially extending flow

passages) across the base (15) of the canister (10), as in also fig. 1 and page 10, lines 6 - 11.

12. With regards to claim 27, Lindberg et al. further disclose:

- the (plural/at least 6 are shown) ribs (i.e. each one from another) being unevenly spaced, as in fig. 1.

13. Concerning claim 28, Lindberg et al. also disclose:

- adjacent ribs being spaced by a rib spacing, the rib spacing varying along the inner surface of the side wall of the canister (10), as in fig. 1.

14. Regarding claim 29, Lindberg et al. disclose a filter element comprising:

- a substantially cylindrical canister (10) having an open (top) end (in the vicinity of member 14) and a side wall having an outer surface and an inner surface defining an internal diameter of the canister (10) and,
- the inner surface having plural axially spaced anti-tracking ribs (spaced annular ridges) projecting radially inward (from the inner surface of the side wall (10) at a distance from the inner surface) and
- a paper roll (12) as filter media and the paper roll (12) having a first diameter greater diameter than the internal diameter of the canister when the paper roll is outside the canister (10) and a second diameter substantially the same as the internal diameter of the

canister so that the paper roll filter media (12) contacts the inner surface between an adjacent two of the plural axially spaced ribs without distortion of the canister when the paper roll is inserted into the canister (10), wherein

- a generatrix defining the outer surface is a straight line, as in fig. 1 of Lindberg et al. (WO 737).

15. With respect to claim 33, Lindberg et al. disclose the inner surface further comprising:

- an annular outward chamfer (14) at the open end of the canister (10), as in fig. 1 and page 10.

16. Concerning claim 34, Lindberg et al. also disclose:

- the outer surface having an outward facing annular rib (14) at the open end, as in fig. 1.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 5 – 6, 26 and 30 - 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindberg et al.

19. With regards to claims 5 - 6, Lindberg et al. has disclosed all the limitations of base claim 4, but failed to disclose the further limitation of the ribs projecting at 1 – 2 mm from the inner surface of the canister (claim 5), and projecting about 1.5 mm from the inner surface of the canister (claim 6). It is considered obvious to one of ordinary skill in the art to modify the height/projection of the ribs from the inner surface of the side wall, depending upon the choice of the user to achieve a desired result which is enough spacing necessary such that the paper roll media could be removed easily from the canister at the same time the spacing inhibits tracking/leaking of the filtrant between the filter element/media (12) and the wall of the canister (10). The case law, *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) has stated that the discovery of an optimum value of a result effective variable in a known process (in this case, the optimum value for the rib projection being in the range of 1 – 2 mm, or about 1.5 mm) is ordinarily within the skill of the art, and thus a prima facie case of obviousness is established.”

20. Concerning claim 26, Lindberg et al. has disclosed all the limitations of base claim 4, but failed to disclose the further limitation of the ribs being formed by corresponding grooves in a male mould member and the grooves being spaced so that as the canister is progressively slid off the male mould member the ribs do not all encounter grooves at the same time. Claim 26 is a

product by process claim. The patentability of a product by process claim is based upon the product (in this instance, a filter element as claimed by claim 4) itself, eventhough the claim is limited and defined by process (forming the ribs using grooves in a male mould member), and therefore, the product in such a claim is unpatentable if it is the same as, or obvious from the product of the prior art, even if the product of the prior art had been made by a different process. See *In re Thorpe*, et al., No. 85-1913 (11-21-85) 227 USPQ pages 964 – 966. In this instance, the prior art, Lindberg et al. do not teach or disclose how the ribs/ridges on the inner surface of the sidewall of the canister are made, and eventhough the process is different from what is being claimed in claim 26, the filter element of Lindberg et al. is still considered an obvious variant of the claimed invention and would not perform differently from that of the claimed invention.

21. With regards to claim 30, Lindberg et al. has disclosed all the limitations of base claim 29, but failed to disclose the further limitation of the ribs numbering 8. Lindberg et al. have shown at least 6 (plural) ribs formed on the inner surface of the side wall of the canister (10). The case law, *In re Harza* [274 F.2d, 124 USPQ 378 (CCPA 1960)] has provided a prima facie case of obviousness, in the instance that a mere duplication of parts (in this instance, having 8 ribs instead of just 6 ribs) for a multiplied effect does not carry any patentable weight or significance unless a new or unexpected result is produced. See also M.P.E.P. section 2144.04 part VI paragraph B.

22. Regarding claim 31, Lindberg et al. further disclose the (plural, at least 6 are shown) ribs (each one from another) being unevenly spaced, as in fig. 1.

Response to Arguments and Amendments

23. Applicant's arguments and amendments filed on 6-2-03 with respect to claims 4 – 11 and 26 - 34 have been considered but are moot in view of the new grounds of rejection based on WO 97/19737 (Lindberg et al.).

24. Applicant's amendments necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne S. Ocampo whose telephone number is (703) 305-1039. The examiner can normally be reached on Mondays to Fridays from 8:30 A.M. to 4:30 P.M..

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


M.S.O.


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